



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,773	11/14/2001	Kiamars Hajizadeh	3873 P 011	1833
7590	12/17/2003		EXAMINER	
Wallenstein & Wagner, Ltd.			SWARTZ, RODNEY P	
53rd Floor			ART UNIT	PAPER NUMBER
311 S. Wacker Drive				
Chicago, IL 60606-6622			1645	

DATE MAILED: 12/17/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/990,773	HAJIZADEH, KIAMARS	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rodney P. Swartz, Ph.D.	1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 15September2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-34 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-34 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 76

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's Response to Office Action, received 15September2003, paper#8, is acknowledged. Claims 1, 4, 6, 7, 11, 14, 16, 22, 23, 25, and 28 have been amended.
2. Claims 1-34 are pending and under consideration.

**Rejection Withdrawn**

3. The rejection of claim 11 under 35 U.S.C. 112, second paragraph, as being indefinite for  for subsequent fastening thereto of the at least a portion the test device", is withdrawn in light of the amendment of the claim.
4. The rejection of claim 4 under 35 U.S.C. 112, second paragraph, lack of antecedent basis for "extract the prion protein", is withdrawn in light of the amendment of the claim.
5. The rejection of claims 1-13 under 35 U.S.C. 112, second paragraph, as being indefinite for step (g), correlating the test result to the animal so the carcass having a positive **or** negative test result may be removed, is withdrawn in light of the amendment of the claims.
6. The rejection of claims 1-34 under 35 U.S.C. 112, first paragraph, scope of enablement for distinguishing between diseased and nondiseased carcasses by detecting merely prion protein using antibodies other than those specific for PrP<sup>SC</sup>, is withdrawn in light of the amendments to the claims.
7. The rejection of claims 1 and 3-13 under 35 U.S.C. 112, first paragraph, scope of enablement for detecting all other diseases in animal carcasses, is withdrawn in light of the amendments to the claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 1645

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are drawn to "a pair of antibodies specific to" PrP<sup>SC</sup>. However, the instant specification teaches only one antibody which is utilized two times. First, it is a labeled antibody and second it is nonlabeled. However, the claims are unclear if this is the embodiment being claimed or if two separate antibodies are being claimed.

### **Conclusion**

8. Claims 1-34 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., whose telephone number is (703) 308-4244.

The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (703)308-3909. The facsimile telephone number for the Art Unit Group is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-2035.

Application/Control Number: 09/990,773  
Art Unit: 1645

Page 4



RODNEY P. SWARTZ, PH.D  
PRIMARY EXAMINER

Art Unit 1645

December 15, 2003